

REMARKS

This Application has been carefully reviewed in light of the Office Action mailed August 14, 2007. At the time of the Office Action, Claims 1-20 were pending in this Application. Claims 1-20 were rejected. Applicants respectfully request reconsideration and favorable action in this case.

Rejections under 35 U.S.C. § 102

Claims 1-20 stand rejected under 35 U.S.C. §102(e) as being anticipated by U.S. Patent No. 5,697,882 or U.S. Patent No. 5,871,469 or U.S. Patent No. 5,683,366 all issued to Eggers et al. ("Eggers"). Applicants respectfully traverse and submit the cited art does not teach all of the elements of the claimed embodiment of the invention.

Claims 1, 3-11 and 17-20 stand rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 4,936,281 issued to Stasz ("Stasz"). Applicants respectfully traverse and submit the cited art does not teach all of the elements of the claimed embodiment of the invention.

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987). Furthermore, "the identical invention must be shown in as complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co. Ltd.*, 868 F.2d 1226, 1236, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989). Applicant respectfully submits that the art cited as anticipatory by the Examiner cannot anticipate the rejected Claims, because the cited art does not show all the elements of the present Claims.

With regard to claims 1 and 20, the Examiner contends that Eggers discloses at least one active electrode terminal having a lumen therethrough and an open electrode port in communication with the electrode lumen, the electrode terminal comprising a body having a suction opening formed on the electrode terminal body and in communication with the electrode lumen. Applicant respectfully submits that claim 1 describes two distinct openings in the electrode terminal—an open electrode port and a suction opening. Applicant's recitation of two different terms is properly interpreted as describing two varying features, as it is a bedrock principle of claim construction that where two different terms are both expressly recited in a claim, the terms cannot mean the same

thing; otherwise, one of the terms would be superfluous. *See Primos, Inc. v. Hunter's Specialties, Inc.*, 451 F.3d 841, 848 (Fed. Cir. 2006).

The Examiner's application of the cited references with regard to claims 1 and 20 would violate the above-recited principle of claim construction, requiring that the open electrode port and suction opening be embodied by the same feature. More specifically, in identifying where the open electrode port and the suction opening are disclosed in Eggers, the Examiner points to essentially the same feature. Eggers discloses only one opening in the electrode terminal/lumen—that described as open distal end 266. The feature identified by the Examiner as the suction opening in Fig. 20 of the reference is not a separate opening, but rather is merely a portion within the electrode lumen 262 in communication with the open distal end 266. As such, Eggers does not also disclose a suction opening that is formed in the body of the electrode terminal, as is described by claims 1 and 20. Therefore, Eggers does not disclose every element of claim 1, and cannot anticipate claim 1. Applicant respectfully submits that claim 1 is in condition for allowance, and requests withdrawal of the rejection.

Claims 2-19 depend either directly or indirectly from claim 1. Applicant repeats and hereby incorporates the remarks made above regarding claim 1. For these reasons, Applicant respectfully submits that claims 2-19 are also allowable over Eggers.

Similarly, Applicant repeats and hereby incorporates the remarks made above with regard to the Examiner's rejection of claims 1 and 20 as anticipated by Stasz. Stasz does not disclose a suction opening formed in the body of an electrode terminal separate from that of the opening at the end of bore 44. As such, Stasz does not disclose every element of claims 1 and 20, and cannot anticipate claims 1 and 20 or the claims that depend therefore. Applicant respectfully submits that claims 1 and 20, as well as dependent claims 2-19, are in condition for allowance, and requests withdrawal of the rejection.

Information Disclosure Statement

Applicants enclose an Information Disclosure Statement and PTO Form 1449, with copies of the references for the Examiner's review and consideration. The Commissioner is hereby authorized to charge \$180 for the IDS fee to Deposit Account No. 50-0359 of ArthroCare Corporation.

CONCLUSION

Applicants have made an earnest effort to place this case in condition for allowance in light of the remarks set forth above. Applicants respectfully request reconsideration of the pending claims.

Applicants hereby authorize the commissioner to charge \$120 for the One-Month Extension and \$180 for the IDS to Deposit Account No. 50-0359 of ArthroCare Corporation.

Applicants believe there are no further fees due at this time, however, the Commissioner is hereby authorized to charge any additional fees necessary or credit any overpayment to Deposit Account No. 50-0359 of ArthroCare Corporation in order to effectuate this filing.

If there are any matters concerning this Application that may be cleared up in a telephone conversation, please contact Applicants' attorney at 512.358.5925.

Respectfully submitted
Attorney for Applicants,



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Date: 12/14/07

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Enclosure: 1) Information Disclosure Statement and PTO Form 1449